

12179-P081P1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The application of: Eller et al.

Serial No.: 09/784,394 Art Unit: 2611
Filed: February 15, 2001 Examiner: Jason Salce
For: SYSTEM AND METHOD FOR SELLING ADVERTISING SPACE ON ELECTRONIC DISPLAYS
USING DIGITAL TELEVISION SPECTRUM

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR 1.192)

1. Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on February 13, 2004.

NOTE: "The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate." 37 CFR 1.192(a) (emphasis added).

2. STATUS OF APPLICANT

This application is on behalf of

- ☐ other than a small entity
☒ small entity

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

- ☒ small entity \$165.00
☐ other than a small entity \$330.00

Appeal Brief fee due \$165.00

CERTIFICATE OF MAILING (37 CFR § 1.8)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

4-7-04

Toni Stanley

(Type or print name of person mailing paper)

(Signature of person mailing paper)

(Page 1 of 3)

4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 CFR 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

- (a) ☐ Applicants petition for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 420.00	\$ 210.00
<input type="checkbox"/> three months	\$ 950.00	\$ 475.00
<input type="checkbox"/> four months	\$ 1,480.00	\$ 740.00
Fee		\$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

- (b) ☒ Applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal Brief fee \$165.00

Extension fee (if any) \$0.00

TOTAL FEE DUE \$165.00

6. FEE PAYMENT

- ☒ Attached is a check in the sum of \$ 165.00

- ☐ Charge Account No. _____ the sum of \$0.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 23-2426 (12179-P081P1).

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 23-2426 (12179-P081P1).

Reg. No.: 36,571


SIGNATURE OF ATTORNEY

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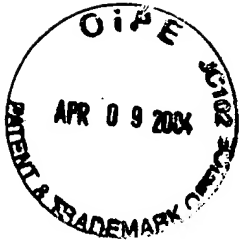
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PATENT



- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application: Eller et al.

Serial No.: 09/784,394

Filed: February 15, 2001

Art Unit: 2611

Examiner: Jason Salce

For: SYSTEM AND METHOD FOR SELLING ADVERTISING SPACE
ON ELECTRONIC DISPLAYS USING DIGITAL TELEVISION
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APPEAL BRIEF

I. REAL PARTY-IN-INTEREST

The real party in interest is SI Diamond Technology, Inc., who is the assignee of the entire right and interest in the present Application.

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 6, 2004.

Signature

Toni Stanley

(Printed name of person certifying)

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II. RELATED APPEALS AND INTERFERENCES

The parent application to this application, Serial No. 09/553,012, is also under an appeal to the Board.

III. STATUS OF CLAIMS

Claims 5-6 and 14-20 are pending in the Application, and also stand rejected.

IV. STATUS OF AMENDMENTS

Amendments to the claims were filed after the final rejection, but not entered by the Examiner.

V. SUMMARY OF THE INVENTION

Outdoor billboards are located throughout the United States and even worldwide. Traditionally, billboards have been of the paper/poster type, where the ad on the billboard must be manually changed on a periodic basis using one or more workers. As a result, for a definitive period of time, usually one month or longer, only a single ad can be displayed on any particular billboard.

FIGURE 2A illustrates an outdoor billboard 201 having an electronic display 200. A processor and memory device, along with driver electronics and software are located at the electronic billboard site. The images to be displayed can be stored within the memory, and then are displayed in a desired manner using software. For example, a multitude of different ads can be displayed at different and preselected frequencies and durations of time. The ads can be uploaded to the billboard system remotely using a digital television broadcast network. See 403 in FIGURE 4 and FIGURE 7. As a result, a central location can upload various ads to various

billboards located across the United States (FIGURE 1 illustrates an example of electronic billboards, noted by X's, throughout the United States), or even worldwide.

Referring to FIGURE 3, a client who wishes to display their ad on a particular billboard somewhere within the world will log onto a network, such as the Internet, and visit the web site operated by the billboard provider. In step 302, the client may view a map with indications where the billboard provider's electronic billboards are located.

In step 303, the client will select a billboard. In step 304, a list of open times and their durations available for ad space at the selected billboard is provided to the client. The client, in step 305, can then select an available time slot and duration. Upon selection of the available time slot and duration, the cost for the ad space may be provided to the client in those instances where a fee is applicable. In step 306, the client will purchase the desired amount of time (if applicable). In step 307, the client proceeds to prepare their own ad (or other information to be displayed) for display. Once the ad is created, then the client may upload the created ad to a central location for approval by the billboard provider in step 308. Certain pre-approved clients may be able to skip step 308 and upload their ad directly to the billboard system. In step 309, once approved, the ad is scheduled by the billboard provider for downloading to the selected billboard system for display at the desired time and duration.

VI. ISSUES

1. Do the provisional patent applications relied upon for priority support the claim limitation "digital television broadcast network"?
2. Are claims 5-6, 14 and 19 properly rejected under 35 U.S.C. § 102 as being anticipated by *Carney et al.* (U.S. Patent No. 6,408,278)?

3. Are claims 15-18 and 20 properly rejected under 35 U.S.C. § 103 as being unpatentable over *Carney* in view of *Hunter* (U.S. Patent No. 6,430,605)?

VII. GROUPING OF CLAIMS

Claims 5-6 and 14 are a first group.

Claims 15-18 are a second group.

Claims 19 and 20 are each to be considered separately.

Reasons for such groupings are in Section VIII.

VIII. ARGUMENT

1. The provisional patent applications relied upon for priority support the claim limitation "digital television broadcast network."

In Paper No. 20, the Examiner agreed that the first, second and third information handling systems recited in the claims are supported within the provisional patent applications. However, the Examiner still asserted that "digital television broadcast network" was not supported by the provisional applications. The Examiner asserted that these applications disclosed a cable network and also that the Internet is also disclosed, but nowhere is there a disclosure of a digital television broadcast network. Applicants respectfully disagree.

Page 5, line 14 of the '602 application (60/130,602) discloses that the ads can be uploaded to the billboard system using various telecommunication systems, including cable. Page 6, lines 4-6 describe how the third information handling system (client computer) will access the billboard provider website over a network. It is well known in the art that access to the Internet may be provided using a cable network. In the '673 application (60/147,673), it is described how data transmission to and from the billboards can be performed using cable technologies. Page 8, lines 17-20. From the attached drawing, it can be then observed that the network connection from the

third information handling system to the billboard provider website can be over a cable network, and the provisional applications also disclose how the ads can be uploaded to the billboard systems over a cable telecommunications system. As a result, Applicants respectfully assert that the provisional applications disclose that the first and second information handling systems of the first and second electronic billboard systems are coupled to the client computer (third information handling system) by a digital television broadcast network.

Furthermore, in the Section 102 rejection of claims 14 and 19 in Paper No. 17, the Examiner has asserted that *Carney* discloses such a coupling of these information handling systems over a digital television network by its teaching of the use of a cable network in column 3, line 6 for each of the Internet "clouds" 22 shown in Figure 3. Therefore, by the Examiner's own admission, the limitation "digital television broadcast network" reads on a cable network, and thus this claim limitation is supported within the provisional patent applications.

The Examiner has asserted that a television network can be either digital or analog and that analog cable only serves customers a limited number of channels where digital cable provides hundreds of channels comparable to satellite, music channels, as well as more advanced pay-per-view features. The Examiner then asserts that disclosing a cable medium for transmission and access to the Internet does not disclose a digital television broadcast network. Applicants respectfully disagree. Cable mediums have been carrying digital television broadcasts for quite a few years now, and also have been carrying the Internet. Whether a broadcaster wants to place only the traditional analog channels or add the digital channels does not change the actual cable medium. When a customer contracts with the cable company to upgrade to a digital package, the cable medium stays the same.

Furthermore, one skilled in the art at the time of the filings of the provisional patent applications would have appreciated that digital television broadcasts could be

carried over cable mediums. As a result, Applicants respectfully assert that the claims are adequately supported within the provisional applications.

2. Claims 5-6, 14 and 19 are not properly rejected under 35 U.S.C. § 102 as being anticipated by *Carney*.

The Examiner is requested to note that the present Application claims benefit to the Parent Application, which claims benefit to Provisional Application Serial No. 60/130,602, filed on April 22, 1999, and also claims benefit to Provisional Application Serial No. 60/147,673 filed on August 6, 1999. The *Carney* Patent was filed on November 10, 1999. Thus, the present Application has a priority based on the provisional applications from which it depends previous to the filing date of the *Carney* Patent. Applicants do recognize that the *Carney* Patent claims benefit to Provisional Application Serial No. 60/107,735, which was filed on November 10, 1998 (hereinafter "the *Carney* Provisional Application"). However, it is clear that the rejected claims are not anticipated by the disclosure in the *Carney* Provisional Application. The *Carney* Provisional Application is merely a filing of an Executive Summary, the kind of which are provided to potential investors. The *Carney* Provisional Application is not the same as the disclosure in the *Carney* Patent, nor is the disclosure in the *Carney* Provisional Application anywhere near in detail to the disclosure in the *Carney* Patent. In fact, Applicants doubt that the *Carney* Provisional Application is even enabling for the inventions claimed in the *Carney* Patent.

More specifically, with respect to claim 14, there is no disclosure in the *Carney* Provisional Application of selecting, via the third information handling system, which of the first and second electronic billboards will display the information. Nor is there a disclosure in the *Carney* Provisional Application of uploading information from the third information handling system over the Internet to the information handling system controlling the selected electronic billboard.

With respect to claims 19-20, Applicants respectfully assert that the Examiner must examine these claims under *In re Donaldson* as set forth in MPEP § 2181. Applicants respectfully assert that clearly the *Carney* Patent and the *Carney* Provisional Application do not teach or suggest claims 19-20 as interpreted in view of the Specification of the present Application.

3. Claims 15-18 and 20 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Carney* in view of *Hunter* (U.S. Patent No. 6,430,605).

Applicants again assert that the *Carney* Patent is not sufficient for purposes of combining with *Hunter*, since the *Carney* Patent is not prior art to the present application by itself and the *Carney* Provisional Application disclosure is not in any way as detailed, nor is it enabling, in order to suffice for the Examiner's purposes. In fact, all of the Examiner's § 103 arguments are insufficient to prove a *prima facie* case of obviousness, since the Examiner is relying upon language cited within the *Carney* Patent. Since this language cited in the *Carney* Patent does not exist within the *Carney* Provisional Application, such Examiner arguments do not provide a *prima facie* case of obviousness.

Respectfully submitted,

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APPENDIX

Claim 5 The method as recited in claim 14 wherein the digital television broadcast network includes a digital television broadcast transmitter for transmitting a digital television signal in a wireless manner, wherein a portion of spectrum of the digital television signal is carrying the information, and wherein the digital television broadcast network further includes a receiver antenna coupled to the information handling system for receiving the digital television signal, wherein the information handling system decodes the digital television signal to extract the information therefrom for display on the electronic display.

Claim 6 The display system method as recited in claim 5, wherein the digital television broadcast transmitter includes a transmitting antenna coupled to a broadcast multiplexor that combines a signal carrying the information with the digital television signal.

Claim 14 A method for displaying information on an electronic billboard, comprising the steps of:

providing a first electronic billboard at a first location;

coupling a first information handling system to the first electronic billboard so that the first information handling system can control information to be displayed on the first electronic billboard;

providing a second electronic billboard at a second location;

coupling a second information handling system to the second electronic billboard so that the second information handling system can control information to be displayed on the second electronic billboard;

coupling the first and second information handling systems to a third information handling system over a digital television broadcast network;

selecting, via the third information handling system, which of the first and second electronic billboards will display the information;

uploading the information from the third information handling system over the Internet to the information handling system controlling the selected electronic billboard; and

displaying the information on the selected electronic billboard.

Claim 15 The method as recited in claim 14, further comprising the steps of:

selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and

displaying the information on the selected electronic billboard during the selected time period.

Claim 16 The method as recited in claim 14, wherein the selected electronic billboard is selected from a list of available electronic billboards which includes the first and second electronic billboards.

Claim 17 The method as recited in claim 16, wherein the list includes a map of the first and second locations.

Claim 18 The method as recited in claim 16, further comprising the step of:
charging an amount of money for the display of the information on the selected electronic billboard.

Claim 19 A system for displaying information on an electronic billboard, comprising:

means for providing a first electronic billboard at a first location;

means for coupling a first information handling system to the first electronic billboard so that the first information handling system can control information to be displayed on the first electronic billboard;

means for providing a second electronic billboard at a second location;

means for coupling a second information handling system to the second electronic billboard so that the second information handling system can control information to be displayed on the second electronic billboard;

means for coupling the first and second information handling systems to a third information handling system over a digital television broadcast network;

means for selecting, via the third information handling system, which of the first and second electronic billboards will display the information;

means for uploading the information from the third information handling system over the Internet to the information handling system controlling the selected electronic billboard; and

means for displaying the information on the selected electronic billboard.

Claim 20 The system as recited in claim 19, further comprising:

means for selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and

means for displaying the information on the selected electronic billboard during the selected time period.

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